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10/511,294

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EXAMINER

GARCIA, ERNESTO

ART UNIT

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3679

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|-------------------------------|--------------------------------|--|
| Office Action Summary | Application No. 10/511,294 | Applicant(s) LENHART, KLAUS | |
| | Examiner Ernesto Garcia | Art Unit 3679 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2007 and 05 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-15 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-12 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election of Species

Claims 13 and 14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 20, 2006.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "41" (Figures 1-3), "42" (Figures 1 and 3), "141" (Figures 3-5), and "142" (Figures 3 and 4) have been used to designate the same fin. Applicant argues that the provision of Rule 84(p)(4) is concern [with] views of the same embodiment of the invention and that they do not concern multiple embodiments. This is not persuasive since the provision does not state that the same part appearing in different "views" of different embodiments should be labeled differently, but rather is concerned with the same part irrespective of the embodiments shown. Further,

nowhere in the provision does it mention "only one embodiment". According to the two views, Figure 1 and Figure 4, the same part, i.e., the same fin is appearing in two different views. Note that using the same part in two or more different embodiments or views should be labeled the same since the parts are the same. Applicant makes the comment that the examiner's assumption that the fins are the same is not correct. In response, it should be noted that the examiner could be incorrect and the applicant could also be incorrect since a different closed analysis of the cross section of Figure 1 reveals that the curved portion is not part of the fin 41 but rather the end of the slot 43 that terminates at the cylindrical shoulder 38. Unless applicant explains what is different between the two fins, the examiner will withdraw the objection. It should be noted that the applicant has not admitted that the fin terminates with a curved end portion either.

Note that the same issue occurs through out other reference characters in the figures. For instance, the same outer tube "12" and "112", and the inner tube "111" and "11" have been designated with different reference characters when the tubes are the same ones. Further, reference characters, "113" must be "13", "132" must be "32", "128" must be "28", "121" must be "21", "122" must be "22", "117" must be "17", "127" must be "27", "123" must be "23", "137" must be "37", and "136" must be "36", in Figures 3-5, because each of these components are the same.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

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replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "a first limit stop" recited in claim 8, line 5, and "a second limit stop" recited in claim 8, line 16.

Claim Rejections - 35 USC § 102

Claims 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by DSI-Sportartikel, German patent publication, DE-8,004,343 U1.

Regarding claim 8, Sportartikel discloses, in Figures 1 and 2, an adjustable-length pole comprising at least one outer tube **1**, an inner tube **3** structured, an inner limit stop **4**, and an exterior limit stop **11**, an adjusting screw **5**, a spreading element **10**, and an axially moveable interior element **9**. The inner tube **3** is dimensioned for insertion into the outer tube **1** in a telescoping fashion. The inner limit stop **4** is disposed at an end of the inner tube **3**. The adjusting screw **5** is axially oriented within the outer tube **1** and supported in a rotationally fixed manner on the end of the inner tube **3**. The exterior limit stop **11** is disposed on a free end of the adjusting screw **5**. The spreading element **10** is structured to be radially pressed apart. The spreading element **10** has a bore **A9** (see marked-up attachment provided in the last Office action) defining an inner cone **A10**. The inner cone **A10** opens towards the end of the inner tube **3**. The spreading element **10** is disposed between the inner limit stop **4** and the exterior limit stop **11** such that the spreading element **10** can move axially within narrow limits. The interior element **9** has an outer cone **A11** structured, dimensioned, and disposed for cooperation with the inner cone **A10** of the spreading element **10**. The interior element **9** has an internal threaded bore **A12** cooperating with the adjusting

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screw **5**. The spreading element **10** and the interior element **9** cooperate and form a spreading device axially supported at the end of the inner tube **3**.

Regarding claim 9, the pole is a ski stick.

Regarding claim 10, the spreading element **10** is configured as a pot. The base of the pot **A13** (see marked-up attachment provided in the last Office action) is penetrated by a free end of the screw **5**, facing away from the inner tube **3**.

Regarding claim 11, the spreading element **10** comprises a cylindrical shoulder **8** having a smaller exterior diameter than the base of the spreading element **10**, and facing the inner tube **3**. The shoulder **8** can be axially guided by a guide piece (the shoulder of feature 4 and enclosing the spring 6) attached to a limit stop surface (the surface of feature 4 that the end of the spring abuts 6) at the end of the inner tube **3** facing the spreading element **10**.

Regarding claim 12, the exterior limit stop **11** is a cap axially secured at the free end of the screw **5** after the spreading element **10** has been set in place.

Claims 8 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Kupsi, 3,145,669.

Regarding claim 8, Kupski discloses, in Figure 6, an adjustable-length pole comprising at least one outer tube **41**, an inner tube **40** structured, an inner limit stop **43a**, and an exterior limit stop **44a**, an adjusting screw **44**, a spreading element **16a**, and an axially moveable interior element **17a**. The inner tube **40** is dimensioned for insertion into the outer tube **41** in a telescoping fashion. The inner limit stop **43a** is disposed at an end of the inner tube **40**. The adjusting screw **44** is axially oriented within the outer tube **41** and supported in a rotationally fixed manner on the end of the inner tube **40**. The exterior limit stop **44a** is disposed on a free end of the adjusting screw **44**. The spreading element **16a** has a bore **27** defining an inner cone **27a**. The inner cone **27a** opens towards the end of the inner tube **40**. The spreading element **16a** is disposed between the inner limit stop **43a** and the exterior limit stop **44a**. The interior element **17a** has an outer cone **17a** structured, dimensioned, and disposed for cooperation with the inner cone **27a** of the spreading element **16a**. The interior element **17a** has an internal threaded bore **27** cooperating with the adjusting screw **44**. The spreading element **16a** and the interior element **17a** cooperate and form a spreading device axially supported at the end of the inner tube **40**.

Regarding claim 15, the interior element **17a** has a protruding fin **35'** guided in an axial slot **29** of the spreading element **16**.

Response to Arguments

Applicant's arguments filed April 23, 2007 have been fully considered but they are not persuasive.

Applicant argues that the DSI_Sportartikel fails to disclose the following features: (1) a spreading element disposed between the first (inner) limit stop and the second (exterior) limit stop such that it can move axially within narrow limits and (2) an axially moveable interior element. This is not persuasive since the spreading element was identified as 10 and the spreading element 10 is disposed between the first limit stop and the second limit stop such that it can move axially within narrow limits. Note that the spreading element is not bonded or glued such that it does not move. With regards to the axially moveable interior element, the examiner has identified the axially moveable interior element as 9.

Applicant argues that the examiner has misunderstood the present invention and the operation of DSI-Sportartikel in several aspects. In response, it should be noted that the method of operation of the invention is not been seek for patentability but rather the structure of the pole. It is possible that the examiner misunderstood the present invention; however, the examiner has not misunderstood the claim.

Applicant argues that the interior element (9) is rotationally fixed to the screw (5) by a counter nut (8) and is therefore not axially moveable along the screw. In response, it should be noted that the nut might act as a stop; however, relative to the screw the interior element is still axially moveable since turning the screw will axially move the interior element 9, which is threaded, upwards relative to Figure 1. There's nothing that prevents the interior element from not moving axially relative to the screw. Notice that features 8 and 9 move towards stop 11 such that 11 and 9 sandwich element 10. Further, a quick machine translation (see attachment) of the reference indicates that the cone 9 "is gone up" or "screwed". Note that screwing something inherently makes the part move axially. Therefore, the element 9 does not rotate together with the screw as applicant alleges. Note that for something to move together, one of the elements has to be permanently fixed to the other as by welding, adhesive, setscrew, or any other permanent connection. This is not the case in the reference since the interior element 9 and the screw are only threaded together without a permanent connection.

Applicant argues that DSI-Sportartikel's spreading element has no "play". Applicant is reminded that patentability is based on the structural differences between the claimed invention and that of the prior art and not how one device distinctively operates relative to the other. If the reference meets all the structural limitations, it will inherently function as claimed since the same structural features are present as claimed. With regards to the "play" feature, it should be noted that the claimed invention

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does not mention “play” in any respect. Further, what structure in the claim corresponds to the “play” feature?

With respect to Kupski, applicant argues that Kupski discloses in column 3, lines 26-30, that the drive cone 17a is held against rotation with respect to the expansion ring 16a by bosses 35'-37'. In response, the examiner has noted the excerpt of column 3, lines 26-30; however, the examiner does not understand how this observation fits into the rejection. Applicant further argues that by the disc 43a, the plain cone 18a is therefore fixed rotationally and axially with respect to the screw, which results in the fact the plain cone 18a always rotates together with the screw with respect to the inner tube. In response, it should be noted that the cone 18a is not permanently fixed to the screw and therefore does not rotate as one unit with the screw. Notice that the cone 18a was inserted axially with respect to the screw and one can axially remove the cone 18a in the same fashion. Accordingly, the plain cone 18a “is axially moveable”. Further, it should be noted that the argument is not commensurate with the rejection since the examiner does not rely on cone 18a at all.

Applicant argues that Kupski fails to disclose at least the spreading element disposed between the first limit stop and the second limit stop such that it can move axially within narrow limits. In response, applicant should review the rejection since the examiner has made clear the spreading element and how it is located between the stops. Note that since the spreading element is between the stops, it inherently “can

move axially within narrow limits". Further, it should be noted that the cone 17 inherently pushes the spreading element axially towards the other cone 18 such that the spreading element 16 can spread and abut tightly against the outer tube.

With respect to Kupski, applicant argues similarly as in DSI-Sportartikel, about the "play" feature. In response, it should be noted that the claimed invention does not mention "play" in any respect. Further, what structure in the claim corresponds to the "play" feature? Doesn't the cone 17 of Kupski move away from the spreading element 16, loosening the connection, and retained by the stop 44a? Apparently, the cone 17a will be move down thus allowing the spreading element 16 to follow due to gravity. Accordingly, the spreading element 16 "can move axially".

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-272-7083. The examiner can normally be reached from 9:30AM-6:00PM. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

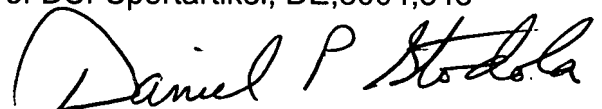
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached at 571-272-7087.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

E.G.

July 16, 2007

Attachment: Three pages of a machine translation of DSI-Sportartikel, DE,8004,343



DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3500